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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC WALKER

Appeal 2009-005396
Application 10/729,162
Technology Center 2100

Decided: December 11, 2009

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-10, 12, 16-21. Claims 11 and 13-15 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

The invention relates to computer-implemented automated electronic product design (Spec. 1).

Independent claim 1 is illustrative:

1. A computer-implemented method for generating a color image, the method comprising
 - associating at least one color with a markup language element capable of accepting image content,
 - applying a grayscale image as content of the element, and
 - applying the at least one color associated with the element as at least one component color of the content image.

References

The Examiner relies upon the following references as evidence in support of the rejections:

Coloring.com, *Coloring.com – free online interactive coloring pages and coloring book*, (identified as pages 1-31) (Nov. 29, 2002), available at <http://web.archive.org/web/20021129165101/http://www.coloring.com/> (“Coloring.com”).

Joe Habraken, *Sams Teach Yourself Microsoft Publisher 2000 in 10 Minutes*, ProQuest Safari Tech Books Online (identified as pages 1-16) (Sams Publishing, 1999) (“Sams Publishing”).

Rejections

Claims 1, 3, 4, 6-8, 10, 16-18, 20, and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Coloring.com.

Claims 2, 5, 9, 12, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coloring.com and Sams Publishing.

ISSUE 1

Appellant argues that “Coloring.com does not teach or suggest an image container having *grayscale* image content” (App. Br. 12). Appellant submits the Specification defines “a ‘grayscale’ image [as] one that is ‘rendered in multiple color tones based on the *combination* of two component colors’” (App. Br. 13). Appellant further argues that “the black outlines of the shape elements [of Coloring.com] are not even part of the image content” (*id.*).

Issue: Did Appellant demonstrate that the Examiner erred in finding that Coloring.com teaches an element having a grayscale image as its content?

ISSUE 2

Appellant argues that in Coloring.com “only one color can be selected at any given time, and the selected color is used to fill the entire image container” (App. Br. 16).

Issue: Did Appellant demonstrate that the Examiner erred in finding that Coloring.com teaches replacing one of the color components of a content image with a selected color?

ISSUE 3

Appellant argues that “Coloring.com fills its shapes as solid colors or as image imports, and not as a pattern fill” (App. Br. 16).

Issue: Did Appellant demonstrate that the Examiner erred in finding that Coloring.com teaches a grayscale image applied as pattern fill content of a shape?

ISSUE 4

Appellant argues that Coloring.com is silent on the limitation of “allowing the user to place an order for the production of one or more products from [an] electronic product design” (App. Br. 18).

Issue: Did Appellant demonstrate that the Examiner erred in finding that Coloring.com teaches allowing the user to place an order for the production of one or more products from an electronic product design?

ISSUE 5

Appellant argues that “Sams Publishing teaches nothing about component colors associated with grayscale images, and therefore does not teach or suggest any mechanism for selecting and applying a component color of a grayscale image” (App. Br. 19).

Issue: Did Appellant demonstrate that the Examiner erred in finding that the combination of the Coloring.com and Sams Publishing references teaches modifying a content image by replacing at least one of the color components of the content image with at least one of the colors in a selected group?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

1. Appellant's Specification teaches that
Of particular relevance to the current invention are "grayscale" images. As is well known in the art, grayscale images are images containing multiple shades or levels of gray. Depending on the system used to create the grayscale image, from 16 to 256 gray levels will typically be available to render the image, ranging from white at one extreme of the range to black at the other. . . . It will also be understood that the use of the term "grayscale" or "grayscale image" does not necessarily mean that the image is either stored or displayed to the user in gray shades, but rather the terms are used herein more broadly to refer generally to image content intended to be rendered in multiple color tones based on the combination of two component colors.
(¶ [0023]).
2. Coloring.com teaches applying a black and white (i.e., grayscale) image (pp. 8, 17) as content of a markup language element (pp. 9-16).
3. Coloring.com teaches selecting a color (p. 20) and then selecting a portion of image content represented as a shape (p. 21), such that the system replaces a color component for that portion of content with the selected color (p. 22).
4. Appellant admits that "Coloring.com provides the user with a color palette which includes a number of different

individual colors” (App. Br. 16). “[O]ne color can be selected at any given time, and the selected color is used to fill the entire image container” (*id.*).

5. Coloring.com shows a link that enables a user to print the graphic (p. 28).

6. Sams Publishing teaches a system that enables the user to select a publication (p. 2-3) such as a business card design (p. 3), and then to select a color scheme for the publication (p. 3-4).

PRINCIPLES OF LAW

Claim interpretation

“In the patentability context, claims are to be given their broadest reasonable interpretations. . . . [L]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Anticipation

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a

claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

Issue 1

Based on Appellant’s arguments in the Appeal Brief, we will decide the appeal with respect to issue 1 on the basis of claim 1 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that “[b]lack and white images are not ‘grayscale’ images as defined in [the] Specification” (App. Br. 13). For “grayscale” to exclude images that are merely black and white, the Specification must be sufficiently clear so that an artisan would understand Appellant’s specialized meaning. *See Multiform Desiccants*, 133 F.3d at 1477. Yet, the Specification does not provide the requisite notice that black and white images are to be excluded.

The Specification notes that grayscale images typically have 16 to 256 gray levels (FF 1). The Specification does not teach that images with a smaller number of gray levels are not grayscale images. Instead, it teaches that black and white are the colors at the extreme range in grayscale images (FF 1), thus black and white images fit the description of 2 level grayscale images.

The Specification provides a specialized meaning for “grayscale.” “Grayscale,” as used in the Specification, is understood “*more broadly* to refer generally to image content intended to be rendered in multiple color tones based on the combination of two component colors” (FF 1) (emphasis added). An artisan would understand that the tones in a grayscale image, as specially defined, are not limited to tones formed by combining black and white, but may include tones formed by two component colors in general. This definition does not narrow the term “grayscale” to exclude black and white images. Instead, this definition expands the term “grayscale” to include images not necessarily “stored or displayed to the user in gray shades” (FF 1).

Appellant argues that “the black outlines of the shape elements are not even part of the image content” (App. Br. 13) because “[t]he outline remains black and is unchangeable” (*id.*). However, nothing in the claims requires that both component colors of the grayscale image be changeable. Therefore, Coloring.com’s teaching of applying a black and white image as content of a markup language element (FF 2) teaches an element having a grayscale image as its content.

For at least these reasons, we find that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's 35 U.S.C. § 102(b) rejection of claims 1, 3, 4, 6-8, 10, 16-18, 20, and 21 or in the Examiner's 35 U.S.C. § 103(a) rejection of claims 2, 5, 9, 12, and 19 with respect to this issue.

Issue 2

Coloring.com teaches selecting a color and a portion of image content represented as a shape (FF 3). This results in the system replacing a color component for that portion of image content with the selected color (FF 3). This comports with Appellant's admission that the selected color fills the entire image container (i.e., the selected portion of image content) (FF 4). As discussed previously, the black and white image content is a grayscale image. Thus, Coloring.com teaches changing a color component (the portion of image content represented as a shape) of a grayscale image.

For at least these reasons, we find that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's 35 U.S.C. § 102(b) rejection of claim 3 with respect to this issue.

Issue 3

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal with respect to issue 3 on the basis of claim 4 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant admits that Coloring.com teaches filling an entire image container (i.e., the selected portion of image content) with a selected color (FF 4). Yet, Appellant provided no arguments or evidence to show that a solid fill is not a type of pattern fill.

For at least these reasons, we find that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's 35 U.S.C. § 102(b) rejections of claims 4 and 8 with respect to this issue.

Issue 4

Coloring.com shows a link that enables a user to print the graphic (FF 5). We agree with the Examiner's unchallenged finding that "request[ing] [a printout of] the electronic design [teaches] plac[ing] an order for the production (printed copy) of the electronic product design" (Ans. 17).

For at least these reasons, we find that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's 35 U.S.C. § 102(b) rejection of claim 21 with respect to this issue.

Issue 5

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal with respect to issue 5 on the basis of claim 2 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that “Sams Publishing does not teach or suggest . . . ‘applying a *grayscale* image as content of the element’ (or similar recitation), which is missing from Coloring.com” (App. Br. 19). As discussed, we find that Coloring.com teaches an element having grayscale image content. Moreover, Sams Publishing is related to publication design systems (FF 6), which are closely related to the invention’s field of computer-implemented automated electronic product design (Spec. 1). Therefore, it would have been obvious to one of ordinary skill in the art to combine the color scheme selection teachings of Sams Publishing (FF 6) with Coloring.com’s teachings of applying a grayscale image as content of a markup language (FF 2). This combination would have taught or suggested modifying a content image by replacing at least one of the color components of a content image (the grayscale image of Coloring.com) by replacing at least one of the color components of the content image with at least one of the colors in a selected group (the color scheme selection of Sams Publishing).

For at least these reasons, we find that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s 35 U.S.C. § 103(a) rejection of claims 2, 5, 9, 12, and 19 with respect to this issue.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has not demonstrated:

1. that the Examiner erred in finding that Coloring.com teaches an element having a grayscale image as its content (Issue 1);

2. that the Examiner erred in finding that Coloring.com teaches replacing one of the color components of a content image with a selected color (Issue 2);

3. that the Examiner erred in finding that Coloring.com teaches a grayscale image applied as pattern fill content of a shape (Issue 3);

4. that the Examiner erred in finding that Coloring.com teaches allowing the user to place an order for the production of one or more products from an electronic product design (Issue 4); and

5. that the combination of the Coloring.com and Sams Publishing references teaches modifying a content image by replacing at least one of the color components of the content image with at least one of the colors in a selected group (Issue 5).

DECISION

We affirm the Examiner's decision rejecting claims 1, 3, 4, 6-8, 10, 16-18, 20, and 21 under 35 U.S.C. § 102(b) and claims 2, 5, 9, 12, and 19 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2009-005396
Application 10/729,162

msc

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